

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): BRUCE S. MARKS

Serial No: 09/778,325

Group Art Unit: 1774

Filed: February 7, 2001

Examiner: Lawrence Ferguson

Att. Docket No.: A1019/20268

Confirmation No.: 4861

For: METALLIZABLE WHITE OPAQUE FILMS, METALLIZED FILMS MADE THEREFORM AND LABELS MADE FROM THE METALLIZABLE FILMS

**SUPPLEMENTAL DECLARATION OF BRUCE S. MARKS
UNDER 37 CFR § 1.132**

I, BRUCE S. MARKS aver and say as follows:

1. On September 24, 2004, I executed a DECLARATION OF BRUCE S. MARKS UNDER 37 C.F.R. § 1.132 (hereinafter "Declaration"), which I understand was attached as Exhibit A to an Amendment of the above-captioned application that was filed in the United States Patent and Trademark on or about September 30, 2004.
2. In the Declaration, I explained the significant differences between cold glue adhesives employed in my invention and cold seal adhesives disclosed in the prior art.
3. In that explanation, I stated that cold seal adhesives are a type of pressure-sensitive adhesive, as that term is employed in a number of patents identified in the Declaration. Although, as stated, a cold seal adhesive is tacky and generally bonds to itself through the application of pressure, the specific disclosure of pressure sensitive adhesives in the prior art, e.g., in Swan et al. U.S. Patent No. 4,965,123 refers to adhesives that are not generally characterized as cold seal adhesives. However, as explained in greater detail hereinafter, although "cold seal adhesives" are not generally referred to as "pressure sensitive adhesives," they both have common properties and functions that are materially different from the cold glue

adhesives employed in my invention and do not have any relationship to such cold glue adhesives.

4. The Swan et al. '123 patent discloses film structures employing pressure-sensitive adhesives, which are not related in any way to the cold glue adhesives employed in my invention.

5. Courtaulds International Publication WO 89/02859 discloses polymer films employing heat seal or cold seal coatings but does not disclose the use of cold glue adhesives of the type employed in my invention.

6. For the reasons stated hereinafter, I state that neither the pressure sensitive adhesives identified in the Swan et al. '123 patent nor "cold seal coatings" referred to in the Courtaulds '859 publication are an "aqueous cold glue adhesive" as is now described and claimed in my above-captioned patent application.

7. I also state that, on information and belief, a person skilled in the art would not understand the disclosure of pressure-sensitive adhesives or cold seal coatings in the Swan et al. '123 patent and the Courtaulds '859 publication, respectively, to be related to, or have any bearing on, "cold glue adhesives" as employed in my invention.

8. Instead, and for the reasons that follow, the terms "cold glue adhesives," "pressure-sensitive adhesives" and "cold seal coatings or adhesives" are well-known in the art, and that "cold glue adhesives" are understood by those of ordinary skilled in the art to represent a class of materials distinct from and not including "pressure-sensitive adhesives" or "cold seal coatings or adhesives."

9. The properties and uses of cold glue adhesives are accurately described in the Declaration made of record earlier in my application.

10. In distinction to cold glue adhesives employed in my invention, cold seal coatings or adhesives and pressure-sensitive adhesives are not applied at the moment of required adhesion. Rather, cold seal coatings or adhesives and pressure-sensitive adhesives are applied to a substrate in a separate operation from the final sealing application. Moreover, cold seal coatings or adhesives are a cohesive designed principally to bond to itself in packaging and similar end-use applications.

11. A cold seal coating or adhesive and a pressure-sensitive adhesive are coated onto a substrate and then, if necessary, dried on the substrate before they are employed to form a sealing function. The cold seal coatings or adhesives and the pressure-sensitive adhesives feel tacky to the touch in a dried condition. In fact, pressure-sensitive adhesives, such as those disclosed in Swan et al. '123 patent most commonly are covered with a release liner before being shipped to an end user.

12. A substrate with a coating of dried and tacky cold seal coating or adhesive thereon is later sent to an end-user, such as a candy manufacturer. The end-user will use the substrate with the coating of dried, cold seal adhesive thereon to seal the package. A substrate with a pressure-sensitive adhesive thereon likewise is usually shipped to be used at a location different from the location at which the pressure-sensitive substrate is manufactured. Moreover, a substrate with a pressure-sensitive adhesive on it almost always is formed with a release covering.

13. A package employing a cold seal coating or adhesive generally is sealed by bonding the cold seal adhesive to itself using pressure at the moment of packaging. A strong bond is instantly formed, with an immediate bond strength far exceeding the bond strength initially created when a label having a cold glue adhesive initially is applied to a container.

14. A substrate employing a pressure-sensitive adhesive on it, although capable of bonding to itself and to other substrates, also instantly forms a strong bond, with an immediate bond strength far exceeding the bond strength initially created when a label having a cold glue adhesive initially is applied to a container.

15. In short, a summary of the major functional differences between cold glue adhesives of the instant invention and cold seal and pressure-sensitive adhesives disclosed in prior art documents is as follows:

A. A cold glue adhesive does not bond to itself or to other substrates if dried first. In distinction, a cold seal coating or adhesive and a pressure sensitive adhesive are tacky in a dry condition, and therefore are capable of providing -- and indeed are intended to provide -- a bonding function when dry.

B. A cold glue adhesive is applied to a label or other substrate at the moment of required adhesion to hold two different substrates (e.g., a label and container) together to form a bond. In distinction, a cold seal adhesive and a pressure-sensitive adhesive employ a two-step process to provide a bond: First, the cold seal or pressure-sensitive adhesive is applied to the substrate, and if necessary, dried. Second, the substrate, with the tacky adhesive thereon, is employed in a separate operation (generally at a different physical location) using only pressure to induce a desired bond or seal. Cold seal adhesives are commonly employed on packaging films to package candy and other products that would be damaged by the required use of heat if a heat seal adhesive were employed on the packaging film.

C. Additionally, an aqueous cold glue adhesive provides a weak initial bond, with the bond strength developing over time as the glue dries. In distinction, a cold seal coating or

adhesive and a pressure-sensitive adhesive form a strong, instant, initial bond; substantially greater than the initial, weak bond provided with a cold glue adhesive.

16. The different functional applications of aqueous cold glue adhesives, on the one hand, and cold seal and pressure-sensitive adhesives, on the other hand, necessitate that cold glue adhesives must have very different formulations from either cold seal adhesives or pressure-sensitive adhesive, which result in cold glue adhesives having very different inherent properties from cold seal adhesives and pressure-sensitive adhesives. The different formulations and thus inherent properties of cold glue adhesives are required in order for the cold glue adhesives to perform the different functions, identified in detail herein above, from the functions performed by cold seal adhesives and pressure-sensitive adhesives.

17. People skilled in the art understand the fact that the overall formulation of cold glue adhesives is completely different from the overall formulation of a cold seal adhesive and a pressure-sensitive adhesive. The fact is that the term "cold glue adhesive" is understood by those of ordinary skill in the art to represent a class of materials having particular formulations and functions distinct from and not including the class of materials encompassed by the term "cold seal adhesives" and "pressure-sensitive adhesives."

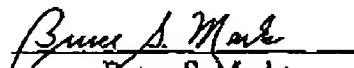
18. Based upon the distinction in the formulations and uses of "cold seal adhesives," "pressure-sensitive adhesives" and "cold glue adhesives," on information and belief people skilled in the art would not be directed or motivated to consider structural features in films specifically determined to be useful with aqueous-based "cold glue adhesives" based upon films disclosed for use with "cold seal adhesives" or "pressure-sensitive adhesives."

19. In my opinion, a person skilled in the art provided the disclosed use of pressure sensitive adhesives in Swan et al. '123 patent and the use of a cold seal adhesive on packaging films in

Courtaulds '859 publication would not find any motivation to employ an aqueous cold glue adhesive on the same substrates and would not find any teaching of correlating the use of an aqueous cold glue adhesive with the amount of a void-creating additive included in the skin layer to which the cold glue adhesive is applied.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 10001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: Nov. 10, 2004


Bruce S. Marks